

Atty. Dkt. No. 200311470-1

REMARKS

This Reply is in response to the Office Action mailed on 11/16/2006. Reconsideration and allowance of the application in view of the following is requested.

I. Specification

A. Title

The Office Action asserts that the "title of the invention" is not descriptive and requires a new title. Applicant traverses this requirement and requests withdrawal of the requirement for a new title.

In particular, the Office action asserts that the title is not descriptive. Applicant submits that the governing standards do not require the title to be "descriptive." Consequently, Applicant submits that the Office Action misstates the requirements of the title and, therefore, improperly requires a new title.

37 CFR 1.72(a) sets forth the requirements of the title as follows: "The title of the invention may not exceed 500 characters in length and ***must be as short and specific as possible.*** (Emphasis added.)" Here, the current title of "media handling" is quite short at only two words. Further, the current title is specific in that it specifies the category (media handling) to which this subject matter pertains. Hence, Applicant submits that the current title complies with the requirements of 37 CFR 1.72(a). Because the current title complies with these requirements, Applicants request withdrawal of the requirement for a new title.

Moreover, Applicants submit that the title suggested in the Office Action is inappropriate for the present matter. Specifically, the title suggested is not "as short and specific as possible" since it includes nine words and is much longer than the present title. Further, the suggested title recites features not in all of the claims and, as such, is not specific to the subject matter recited in the claims. For example, claim 19 does not recite "a device" and other claims do not recite "cups". Accordingly, the suggested title is longer than possible and is not specific to claimed

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subject matter. Thus, Applicants submit that the current title complies with the title requirements and that the requirement for a new title be withdrawn.

B. Disclosure objections

The Office Action objects to the disclosure for alleged informalities. Applicants traverse these objections and submit that the disclosure is compliant. Applicant submits that these objections are not founded in patent application requirements and are therefore improper. Hence, Applicants request withdrawal of these objections.

i. Grippers

Specifically, the Office Action objects to the disclosure because "there is no numerical identifier for "grippers" in paragraph [00010]. Applicant submits that there is no requirement to identify grippers with a numerical identifier in this paragraph. In this regard, Applicant submits that grippers are not shown in the figure (figure 1) being described in paragraph [00010] and, since this feature is not shown in this figure, a numerical identifier is not required. Further, the description of FIG. 2 clearly associates a numerical identifier with grippers. Indeed, at paragraph [00018], the application makes explicit reference to "grippers 204". Lastly, Applicant submits that the disclosure and drawings comply with the requirements of 37 CFR 1.84. Consequently, Applicant requests withdrawal of this objection.

ii. (FIG. 1)

Next, the Office Action objects to the disclosure because: "add '(FIG. 1)' after 116 on line 4 of paragraph [00014] for clarity." Applicant traverses this requirement on the basis that there is no basis in the statute, CFR, or MPEP to require Applicant to make this amendment to the disclosure. Moreover, Applicant submits that from review of the disclosure and drawings, it is quite clear that identifier 116 is found in FIG. 1. Applicant notes that the Office Action doesn't require addition of "(FIG. 1)" after other of the numerical identifiers of paragraph [00014] or elsewhere in the disclosure. Further, it is evident from the disclosure that paragraph [00014]

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describes the structure illustrated in FIG. 1. Withdrawal of this objection is requested.

iii. Additional numerical identifier for drum

The Office Action also objects to the disclosure because "there is on numerical identifier for 'drum' of paragraph [00018], line 2." Applicant traverses this requirement on the basis that there is no basis in the statute, CFR, or MPEP to require Applicant to make this amendment to the disclosure. Further, the disclosure does provide a numerical identifier for 'drum'. Indeed, the first two sentences of paragraph 18 include the numerical identifier for 'drum' as follows.

[00018] In one embodiment, the cups 130 are compressed by the **drum 104** as cups 130 and the drum come into contact and vacuum is raised on the print media 110. The grippers 204 on the **drum 104** move to release the print media 110. (Emphasis added).

Consequently, Applicant submits that this objection to the disclosure is misplaced due to ample references to a numerical identifier for drum 104. Withdrawal of this objection is requested.

iv. Vacuum

Additionally, on page 3, the Office Action objects to the disclosure on the basis that "it is unclear if the phrase "vacuum is raised on the print media 110" in paragraph [00018] is indicating that the pressure increases or decreases." Applicant submits that this language is quite clear to those skilled in the art and familiar with operation of vacuum hold down systems for media. When the cups contact the print media, the vacuum is raised within the cup, thereby lowering the pressure within the cup to create more of a vacuum. Because of the clarity of this usage to those of ordinary skill in the art, Applicants submit that this language is appropriate and sufficient clear. Accordingly, Applicants request withdrawal of this objection.

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II. Claim Rejections 35 USC § 112

Claims 12, 13, and 17 stand rejected under 35 USC § 112, second paragraph. Applicant is amending claims 12 and 13 to address the antecedent basis issues raised in the Office Action and submits that these amendments do not relate to patentability and do not alter the scope of these claims. Rather, these amendments are made to improve claim syntax. As such, Applicant submits that these rejections are overcome. Withdrawal of these rejections is requested.

Claim 17 is cancelled, thus rendering moot the rejection thereof.

III. Claim Rejections § 102

Claims 1, 2, 4, 6-9, and 12 stand rejected as anticipated by U.S. Patent No. 2, 231,339 to Krueger. Applicant traverses these rejections as applied to the claims as amended.

Claim 1 is amended to recite "a conveyor adjacent to the cups for transferring the print media from the cups to a print engine." Applicant submits that Krueger does not teach any such conveyor and, as such, Krueger does not anticipate claim 1 as amended.

Claims 2 and 4 depend upon claim 1 and are allowable for at least the same reasons claim 1 is allowable.

Claim 6 is rewritten in independent form and Applicant submits that the scope of claim 6 is not changed by being written in independent form. Further, Applicant submits that claim 6 is not anticipated by Krueger at least by reciting "four cups are mounted on the support and are arranged in a line with middle cups being in the first plane and outer cups being in the second plane." Applicant submits that Krueger does not teach "four cups" arranged as recited in claim 6. The Office Action on page 6 concedes that "Krueger and Hudson do not directly show at least four suction members." (Office Action, page 6). Accordingly, Applicant submits that the rejection of claim 6 is improper and should be withdrawn.

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Claim 7 is amended as follows.

7. (Currently Amended) An assembly for handling sheet material, the assembly comprising:
a rotor having an axis of rotation;
coupling members mounted on the rotor for adhering sheet material to the coupling members by suction;
wherein at least one of the coupling members is disposed a first distance from the axis of rotation and another of the coupling members is disposed a second distance from the axis of rotation, the first and second distances being different;
a support having at least three cups mounted thereto, the cups being adjacent to the coupling members for receiving sheet material from the coupling members.

Hence, in addition to reciting "coupling members mounted on the rotor for adhering sheet material to the coupling members by suction", claim 7 also recites "a support having at least three cups mounted thereto, the cups being adjacent to the coupling members for receiving sheet material from the coupling members." Applicant submits that Krueger does not disclose both of these features and, as such, does not anticipate claim 7. Rather, Krueger discloses pads 90 and shaft 67. Withdrawal of the rejection of claim 7 is requested.

Claims 8 and 9 depend upon claim 7 and are allowable for at least the same reasons claim 7 is allowable.

Claim 12 is rewritten in independent form and Applicant submits that the scope of claim 12 is not changed by being written in independent form. Claim 12 also recites "a drum positioned adjacent to cups for delivering sheet material to the cups, the drum having a gripper disposed thereon for selectively maintaining the sheet material on the drum". Applicant submits that claim 12 is not anticipated by Krueger since Krueger fails to disclose a "drum having a gripper disposed thereon for selectively maintaining the sheet material on the drum." In this regard, the Office Action merely states "drum (70); gripper (70)". Applicant submits that the rollers 70 do not satisfy this claim language since these merely comprise rollers without any type of gripper. Withdrawal of this rejection is requested.

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IV. Claims 19-21

Claim 19 is rejected as anticipated by U.S. Patent No. 4,378,734 ("Wirz"). In particular, the Office Action relies on lines 35-41 of column 1 of Wirz. Applicants submit that claim 19 is not anticipated by lines 35-41 of column 1 of Wirz on the basis that this text does not teach at least "the different locations being disposed along a line orthogonal to a direction of movement." Applicants note also that this section of Wirz appears to describe teachings of a different document, namely German Pat. No. 24 52 096.

Claim 20 is allowable for similar reasons as those set forth above with respect to claim 19 and further for the reasons set forth below.

Claims 20 and 21 recite means-plus-function elements. In this regard, the Office Action notes that 20, 21 "appear to be written to invoke 35 U.S.C. §112 6th paragraph." (Office Action, page 4). However, the Office Action states that the examiner "has construed the claims as not invoking 35 U.S.C. §112 6th paragraph" because "applicant has not formally invoked 35 U.S.C. §112 6th paragraph. Applicant traverses this position on the basis that Applicant is not required to "formally" invoke 35 U.S.C. §112 6th paragraph or make a "formal" statement to this effect. Rather, Applicant submits that the examiner must follow the guidelines set forth at MPEP 2181 in determining whether 35 U.S.C. §112 6th paragraph is Invoked.

In particular, MPEP 2181 states as follows.

A claim limitation will be presumed to invoke 35 U.S.C. 112, sixth paragraph, if it meets the following 3-prong analysis:

- (A) the claim limitations must use the phrase "means for" or "step for;"
- (B) the "means for" or "step for" must be modified by functional language; and
- (C) the phrase "means for" or "step for" must not be modified by sufficient structure, material, or acts for achieving the specified function.

Accordingly, Applicant requests that the examiner apply the standards set forth in MPEP 2181 and examine any elements that are presumed to Invoked 35 U.S.C. §112 6th paragraph in accordance with MPEP 2181-2183.

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Further, MPEP 2183 sets forth the requirements for a prima facie case of equivalence of a means-plus-function claim element. In particular, this MPEP section specifies that Examiner provide **"rationale in the Office action as to why the prior art element is an equivalent."** The Office Action is silent in this respect and as such, does not establish prima facie equivalence of any elements recited in claims 20, 21 that are subject to a 35 U.S.C. §112 6th paragraph construction. Consequently, the Office Action also fails to allege equivalence of such elements. As such, Applicants cannot fully evaluate this basis of rejection of claims 20, 21 since it is not set forth as the MPEP requires. Consequently, Applicant requests withdrawal of the rejection of claims 20,21. Withdrawal of this rejection is requested.

V. Claim Rejections under 35 USC § 103(a)

Claims 5, 13, 14, 16, and 17 are rejected under 35 USC § 103(a) as unpatentable over Krueger in view of Hudson (U.S. 2004/0113349).

Claim 5 depends upon claim 1 and is allowable at least for the same reasons claim 5 is allowable.

With respect to claim 13, Applicant submits that there is no motivation to modify the Krueger sheet feeding mechanism with a print engine for forming an image on the medium. Indeed, Krueger is "concerned with mechanism for feeding metal sheets from which tin cans and the like are formed." (Col. 1, lines 6-8). As such, Krueger is not directed to printing or to having print media. Indeed, there is no teaching in either Krueger nor Hudson relating to the desirability of printing on metal sheets handled by the Krueger mechanism. Moreover, there is no teaching that liquid electrophotography techniques would be effective in printing on the Krueger metal sheets. Consequently, because neither Krueger nor Hudson disclose the desirability or feasibility of printing on the Krueger metal sheets, Applicants submit that the Office Action fails to establish prima facie obviousness of claim 13 due to a lack of motivation to modify Krueger with the teachings of Hudson. (See 2143.01 "THE PRIOR ART MUST SUGGEST THE DESIRABILITY OF THE CLAIMED INVENTION"). Withdrawal of this rejection is requested.

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Further, the Office Action fails to establish *prima facie* obviousness of claim 13 because of a lack of reasonable expectation of success in modifying Krueger with a print engine to print on the Krueger metal sheets. "The prior art can be modified or combined to reject claims as *prima facie* obvious as long as there is a reasonable expectation of success." MPEP 2143.02. Here, the Office Action does not establish a reasonable expectation of successfully modifying Krueger to print on metal sheets since neither Krueger nor Hudson disclose the desirability or feasibility of printing on the Krueger metal sheets. Withdrawal of this basis of rejection is requested for this additional reason.

Claims 14 and 16 depend upon claim 13 and are allowable for at least the same reasons claim 13 is allowable.

Applicants submit that the Office Action also fails to establish *prima facie* obviousness of claim 17 for reasons similar to those set forth above with respect to claim 13. Withdrawal of this rejection is requested.

Claim 15 depends upon claim 13 and is allowable for at least the same reasons as claim 13.

Claims 3 and 11 are cancelled.

VI. Allowable Subject Matter

Claims 10 and 18 are rewritten in independent form and thus Applicant submits that these claims overcome the objections thereto.

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VII. Conclusion.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 08-2025. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 08-2025. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 08-2025.

Respectfully submitted,

Date

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